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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO.      | CONFIRMATION NO.       |
|--|-------------|-----------------------|--------------------------|------------------------|
| 10/695,232   | 10/28/2003  | William Joseph Semper | 2003.10.001.WS0          | 4956                   |
| 23990  | 7590        | 08/23/2007            |                          |                        |
| DOCKET CLERK<br>P.O. DRAWER 800889<br>DALLAS, TX 75380 |             |                       | EXAMINER<br>HASHEM, LISA |                        |
|  |             |                       | ART UNIT<br>2614         | PAPER NUMBER           |
|  |             |                       | MAIL DATE<br>08/23/2007  | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                        |  |
|------------------------------|------------------------|------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b>    |  |
|                              | 10/695,232             | SEMPER, WILLIAM JOSEPH |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>        |  |
|                              | Lisa Hashem            | 2614                   |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3-2-04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1, 4, 7, 9, 10, 11, 13, 19, 21, and 23 are objected to because of the following informalities: the acronym 'IP' is not defined. Appropriate correction is required.
2. Claims 4 and 16 are objected to because of the following informalities: the acronym 'CM' is not defined. Appropriate correction is required.

### ***Claim Objections***

3. Claims 10 and 22 are objected to because of the following informalities: the limitation 'an Assignment Request message containing said IP address of said second base station said mobile identifier value' does not make sense. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 14-23 recite the limitation "the method". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-6 and 13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 6,317,609 by Alperovich et al, hereinafter Alperovich.

Regarding claim 1, Alperovich discloses a wireless network (Fig. 4) for providing a packet data call connection between a source mobile station (MS) (Fig. 4, 20a) and a destination mobile station (MS) (Fig. 4, 20b) in a coverage area of said wireless network, said wireless network comprising: a first base station (Fig. 4: 23a, 24a) capable of wirelessly communicating with said source mobile station; a second base station (Fig. 4: 23b, 24b) capable of wirelessly communicating with said destination mobile station; and a mobile switching center (Fig. 4, 14b) capable of connecting said first and second base stations, wherein said first base station is capable of receiving a first message from said source mobile station requesting an MS-MS packet data call connection to said destination mobile station (col. 5, lines 2-9) and, in response to said first message, said first base station initiates establishment of said MS-MS packet data call connection on a local IP network (Fig. 4, 230) coupling said first and second base stations (col. 5, lines 30-57).

Regarding claim 2, the wireless network as set forth in Claim 1, wherein Alperovich discloses said first message comprises an Origination message having a service option field indicating that said MS-MS packet data call connection is requested (col. 5, lines 2-9).

Regarding claim 3, the wireless network as set forth in Claim 1, wherein Alperovich discloses said first base station responds to said first message by transmitting a second message to said mobile switching center, said second message indicating that said MS-MS packet data call connection to said destination mobile station is requested (col. 5, lines 10-57).

Regarding claim 4, the wireless network as set forth in Claim 3, wherein Alperovich discloses said second message comprises a CM Service Request message containing said service option indicating that said MS-MS packet data call connection is requested and containing a phone number associated with said destination mobile station and an IP address of said first base station (Fig. 4: 358, 428; col. 5, lines 10-57).

Regarding claim 5, the wireless network as set forth in Claim 3, wherein Alperovich discloses said mobile switching center responds to said second message by transmitting a third message to said second base station, said third message indicating that said MS-MS packet data call connection is requested (col. 6, lines 21-33).

Regarding claim 6, the wireless network as set forth in Claim 5, wherein Alperovich discloses said third message is a Paging Request message (col. 6, lines 21-33).

Regarding claim 13, Alperovich discloses for use in a wireless network (Fig. 4) comprising:

- i) a first base station (Fig. 4: 23a, 24a) that wirelessly communicates with a source mobile station (MS) (Fig. 4, 20a),
- ii) a second base station (Fig. 4: 23b, 24b) that wirelessly communicates with a destination mobile station (MS) (Fig. 4, 20b), and

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iii) a mobile switching center (Fig. 4, 14b) that connects the first and second base stations, a method of providing a MS-MS packet data call connection between the source mobile station and the destination mobile station comprising the steps of:

in the first base station, receiving a first message from the source mobile station requesting a MS-MS packet data call connection to the destination mobile station (col. 5, lines 2-9); in response to the first message, establishing the MS-MS packet data call connection on a local IP network (Fig. 4, 230) coupling the first and second base stations (col. 5, lines 30-57).

Regarding claim 14, the method as set forth in Claim 13, wherein Alperovich discloses the first message comprises an Origination message having a service option field indicating that the MS-MS packet data call connection is requested (col. 5, lines 2-9).

Regarding claim 15, the method as set forth in Claim 13, wherein Alperovich discloses further comprising the step of transmitting a second message from the first base station to the mobile switching center, the second message indicating that the MS-MS packet data call connection to the destination mobile station is requested (col. 5, lines 10-57).

Regarding claim 16, the method as set forth in Claim 15, wherein Alperovich discloses the second message comprises a CM Service Request message containing the service option indicating that the MS-MS packet data call connection is requested and containing a phone number associated with the destination mobile station (Fig. 4: 358, 428; col. 5, lines 10-57).

Regarding claim 17, the method as set forth in Claim 15, wherein Alperovich discloses further comprising the step of transmitting a third message from the mobile switching

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center to the second base station in response to the second message, the third message indicating that the MS-MS packet data call connection is requested (col. 6, lines 21-33).

Regarding claim 18, the method as set forth in Claim 17, wherein Alperovich discloses the third message is a Paging Request message (col. 6, lines 21-33).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 7-12 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alperovich, as applied to claims 1 and 13, respectively, and in view of U.S. Pat. Appl. Publ. 2003/0119518 by Cleveland et al, hereinafter Cleveland.

10. The applied reference (Cleveland) has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that

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the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Regarding claim 7, the wireless network as set forth in Claim 7, wherein Alperovich discloses said second base station responds to said third message by transmitting a fourth message to said mobile switching center (col. 6, lines 27-35).

Alperovich does not disclose said fourth message containing an IP address of said second base station on said local IP network.

Cleveland discloses a wireless network (Fig. 1; Fig. 5) for providing a packet data call connection between a source mobile station (MS) and a destination mobile station (MS) (Fig. 5, 111) in a coverage area of said wireless network, said wireless network comprising:  
a second base station (Fig. 5, 101) capable of wirelessly communicating with  
said destination mobile station (Fig. 5, 111); and  
a mobile switching center (Fig. 5, MSC); receiving a first message from said source mobile station requesting an MS-MS packet data call connection to said destination mobile station (section 0026; 0068).

Transmitting a second message to said mobile switching center, said  
second message indicating that said MS-MS packet data call connection to said destination mobile station is requested (section 0068).



Wherein said mobile switching center responds to said second message by transmitting a third message to said second base station, said third message indicating that said MS-MS packet data call connection is requested (section 0068-0069).

Wherein said second base station responds to said third message by transmitting a fourth message to said mobile switching center, said fourth message containing an IP address of said second base station on said local IP network (section 0070-0072).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the wireless network of Alperovich to include said fourth message containing an IP address of said second base station on said local IP network including as taught by Cleveland. One of ordinary skill in the art would have been lead to make such a modification to identify an IP address of said second base station that is a node on the IP network.

Regarding claim 8, the wireless network as set forth in Claim 7, wherein Alperovich discloses said fourth message comprises a Paging Response message (col. 6, lines 27-35)).

Regarding claim 9, the wireless network as set forth in Claim 7, wherein Cleveland discloses said mobile switching center responds to said fourth message by transmitting a fifth message to said first base station, said fifth message containing said IP address of said second base station and a mobile identifier value associated with said destination mobile station (section 0072).

Regarding claim 10, the wireless network as set forth in Claim 9, wherein Cleveland discloses said fifth message comprises an Assignment Request message containing said IP address of said second base station said mobile identifier value (section 0071-0073, 0081).

Regarding claim 11, the wireless network as set forth in Claim 9, wherein Cleveland discloses said first base station responds to said fifth message by using said IP address of said second base station to establish a packet data bearer connection to said second base station via said local IP network (section 0071-0073, 0081).

Regarding claim 12, the wireless network as set forth in Claim 11, wherein Alperovich discloses said first base station transmits said mobile identifier of said destination mobile station to said second base station in order to identify data packets from said source mobile station that are directed to said destination mobile station (col. 5, lines 2-42).

Regarding claim 19, the method as set forth in Claim 17, wherein Alperovich discloses the step of transmitting a fourth message from the second base station to the mobile switching center in response to the third message (col. 6, lines 27-35).

Alperovich does not disclose said fourth message containing an IP address of said second base station on said local IP network.

Cleveland discloses a wireless network (Fig. 1; Fig. 5) for providing a packet data call connection between a source mobile station (MS) and a destination mobile station (MS) (Fig. 5, 111) in a coverage area of said wireless network, said wireless network comprising:

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a second base station (Fig. 5, 101) capable of wirelessly communicating with said destination mobile station (Fig. 5, 111); and  
a mobile switching center (Fig. 5, MSC); receiving a first message from said source mobile station requesting an MS-MS packet data call connection to said destination mobile station (section 0026; 0068).

The step of transmitting a second message to said mobile switching center, said second message indicating that said MS-MS packet data call connection to said destination mobile station is requested (section 0068).

The step of transmitting a third message from the mobile switching center to the second base station in response to the second message, said third message indicating that said MS-MS packet data call connection is requested (section 0068-0069).

The step of transmitting a fourth message from the second base station to the mobile switching center in response to the third message, said fourth message containing an IP address of said second base station on said local IP network (section 0070-0072).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Alperovich to include said fourth message containing an IP address of said second base station on said local IP network including as taught by Cleveland. One of ordinary skill in the art would have been lead to make such a modification to identify an IP address of said second base station that is a node on the IP network.

Regarding claims 20-23, please see the rejections to claims 8-11 above.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

12. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-8300 (for formal communications intended for entry)

**Or call:**

(571) 272-2600 (for customer service assistance)

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lh

August 16, 2007

  
FAN TSANG  
SUPERVISORY PATENT EXAMINER  
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